

## **REMARKS**

By this Amendment, Applicants amend the title; amend claims 1 and 7 to more appropriately define the invention; and add new claims 12-17 to protect additional aspects related to the present invention.

In the Office Action (“OA”), the Examiner objected to the title of the invention; objected to claims 1-11; rejected claims 1, 3-5, and 9-11 under 35 U.S.C. § 103(a) as unpatentable over Jenkins et al., U.S. Patent No. 5,719,744, (“*Jenkins*”) in view of Quintana et al., U.S. Patent No. 6,522,531, (“*Quintana*”); rejected claims 2 and 8 under 35 U.S.C. § 103(a) as unpatentable over *Jenkins* in view of *Quintana* as applied to claim 1, and further in view of Wong et al., U.S. Patent No. 6,509,657, (“*Wong*”); and rejected claim 6 under 35 U.S.C. § 103(a) as unpatentable over *Jenkins* in view of *Quintana* as applied to claim 1, further in view of Newman et al., U.S. Patent No. 5,844,824, (“*Newman*”). Applicants address these objections and rejections as set forth below.

### **I. Response to Objections**

The Examiner alleged that the title of the invention was not descriptive. Applicants amend the title to read --MOBILE BODY-SUPPORTED COMPUTER WITH BATTERY--. Applicants submit that this title is descriptive and request that the Examiner withdraw the objection to the title.

Additionally, the Examiner objected to claims 1-11 for informalities and indicated that the claim numbering should be written at the beginning of the claims. Applicants point out that the claim numbering appeared at the beginning of each claims, but on a different line. Nonetheless, Applicants have moved the claim numbering so as to appear

directly before the text of the claim. Accordingly, Applicants request that the Examiner withdraw the objection to the claims.

## **II. Response to Rejections Under 35 U.S.C. § 103(a)**

The Examiner rejected claims 1, 3-5, and 9-11 under section 103(a) as unpatentable over *Jenkins* (U.S. Patent No. 5,719,744) in view of *Quintana* (U.S. Patent No. 6,522,531); rejected claims 2 and 8 under section 103(a) as unpatentable over *Jenkins* in view of *Quintana* as applied to claim 1, and further in view of *Wong* (U.S. Patent No. 6,509,657); and rejected claim 6 under section 103(a) as unpatentable over *Jenkins* in view of *Quintana* as applied to claim 1, further in view of *Newman* (U.S. Patent No. 5,844,824). In response, Applicants submit that a *prima facie* case of obviousness has not been established in any of these rejections.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (quoting *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970)). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. M.P.E.P. § 2143 at 2100-122 to 127.

A *prima facie* case of obviousness has not been established in each rejection because the applied references, whether taken alone or in combination, fail to teach or

suggest each and every claim element. Applicants will address each rejection separately in further detail.

**A. *Jenkins* in view of *Quintana* (Claims 1, 3-5, 9-11)**

Claim 1 is directed to a mobile body supported computer comprising a combination of elements including, *inter alia*, “a computer housing ... an integral battery with casing said casing is at least partially constructed of a thermally non-conducting material, said housing having outside surfaces that when in use at least a portion are closest to the body of the user, said thermally non-conducting casing ... providing a user contact area on said mobile body supported computer that will not result in a burn injury.” Claim 7 is directed to a mobile body supported computer comprising similar recitations.

In the rejection, the Examiner admitted that *Jenkins* “does not disclose an integral battery with casing, which is at least partially constructed of a thermally non-conducting material.” (OA at 3.) Nonetheless, the Examiner alleged that *Quintana* discloses “a wearable personal computer having a battery wherein the casing is constructed of a thermally non-conducting material. (OA at 3.) Applicants, however, submit that the Examiner has misconstrued *Quintana* and *Quintana* fails to teach a battery as recited in claims 1 and 7.

*Quintana* is directed to a wearable computer system for use by fire fighters. *Quintana* discloses that the wearable computer system includes a computer 300 housed in a fire protective casing 325 and a battery 400 housed in a fire protective casing 450. *Quintana*, Figure 1. *Quintana*, however, discloses that computer 300 and battery 400 are housed separately in casing 325 and casing 450, respectively. Thus, battery 400 or casing

450 do not provide any contact area for the computer since they are housed separately in different casings.

Therefore, *Quintana* fails to teach or suggest at least “an integral battery with casing said casing is at least partially constructed of a thermally non-conducting material ... said thermally non-conducting casing ... providing a user contact area on the mobile body supported computer that will not result in a burn injury,” as recited in claims 1 (claim 7 contains a similar recitation). Accordingly, a *prima facie* case of obviousness has not been established for claims 1 and 7 because *Jenkins* and *Quintana* fail to teach or suggest all the claim elements. For at least this reason, the rejection of claims 1 and 7 under section 103(a) is improper and should be withdrawn.

Claims 3-5 depend from claim 1 and claims 9-11 depend from claim 7. Thus, a *prima facie* case of obviousness has not been established for claim 3-5 and 9-11 for at least the reason stated above. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” M.P.E.P. § 2143.03 at 2100-126 (citing *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)).

**B. *Jenkins* in view of *Quintana* and further in view of *Wong* (Claims 2 and 8)**

Claim 2 depends from claim 1 and, thus, incorporates the elements of that claim. Claim 8 depends from claim 7 and, thus, incorporates the elements of that claim. As mentioned above, *Jenkins* and *Quintana* fail to teach or suggest at least “an integral battery with casing said casing is at least partially constructed of a thermally non-conducting material ... said thermally non-conducting casing ... providing a user contact

area on the mobile body supported computer that will not result in a burn injury,” as incorporated in claims 2 and 8. (See current response, remarks, § II(A).)

Moreover, *Wong* fails to cure the deficiencies of *Jenkins* and *Quintana*. Since *Wong* fails to cure the deficiencies of *Jenkins* and *Quintana*, *Jenkins*, *Quintana*, and *Wong*, whether taken alone or in combination, fail to teach or suggest all the elements of claims 2 and 8. Thus, a *prima facie* case of obviousness has not been established for claims 2 and 8. For at least this reason, the rejection of claims 2 and 8 under section 103(a) is improper and should be withdrawn.

**C. *Jenkins* in view of *Quintana* and further in view of *Newman* (Claim 6)**

Claim 6 depends from claim 1 and, thus, incorporates the elements of that claim. As mentioned above, *Jenkins* and *Quintana* fail to teach or suggest at least “an integral battery with casing said casing is at least partially constructed of a thermally non-conducting material ... said thermally non-conducting casing ... providing a user contact area on the mobile body supported computer that will not result in a burn injury,” as incorporated in claim 6. (See current response, remarks, § II(A).)

Moreover, *Newman* fails to cure the deficiencies of *Jenkins* and *Quintana*. Since *Newman* fails to cure the deficiencies of *Jenkins* and *Quintana*, *Jenkins*, *Quintana*, and *Newman*, whether taken alone or in combination, fail to teach or suggest all the elements of claim 6. Thus, a *prima facie* case of obviousness has not been established for claim 6. For at least this reason, the rejection of claim 6 under section 103(a) is improper and should be withdrawn.

### **III. New Claims**

Applicants add new claims 12-17 to protect additional aspects related to the present invention. Applicants submit that claims 12-17 are patentable over the applied prior art references.

Specifically, claims 12 is directed to a mobile body supported computer comprising a combination of elements including, *inter alia*, “a computer housing, the computer housing including substantially all of components of a conventional computer, having a first surface to be against a users body, and a second surface located opposite to the first surface; [and] a heat insulating grille positioned on the second surface.”

Claim 13 is directed to a mobile body supported computer comprising a combination of elements including, *inter alia*, “a computer housing, the computer housing including substantially all of components of a conventional computer, having a first surface to be against a users body, and a second surface located opposite to the first surface ... an integral battery positioned on at least a portion of the first surface and contained within a casing, the casing being partially constructed of a thermally non-conducting material.”

Claim 14 is directed to a mobile body supported computer comprising a combination of elements including, *inter alia*, “a computer housing, the computer housing including substantially all of components of a conventional computer, having a first surface near a user’s body, and a second surface located opposite to the first surface; [and] a heat insulating member positioned on at least one of the first surface or the second surface.”

Claim 15 is directed to a mobile body supported computer comprising a combination of elements including, *inter alia*, “a computer housing, the computer housing including substantially all of components of a conventional computer, having a first surface near a user’s body, and a second surface located opposite to the first surface; [and] means for inhibiting heat conduction positioned on at least one of the first surface or the second surface.”

Claim 16 is directed to a mobile body supported computer comprising a combination of elements including, *inter alia*, “a computer housing; a heat insulating grille located on at least a portion of the computer housing; [and] an integral battery with casing, the casing being at least partially constructed of a thermally non-conducting material ... wherein the computer housing includes substantially all of the components of a conventional computer and the thermally non-conducting casing or the heat insulating grille providing a user contact area on the computer that will not result in a burn injury.”

Claim 17 depends from either claim 1 or 16.

None of the applied references teaches or suggests at least the claim elements recited above. Thus, Applicants submit that claims 12-17 are patentable over the applied prior art references.

#### IV. Conclusion

For at least mentioned above, Applicants submit that the rejections of the pending claims are improper and should be withdrawn. Applicants submit that the present claims are in condition for allowance and request reconsideration and allowance of the pending claims.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Bryan S. Latham", written over a horizontal line.

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